

REMARKS

The present amendment and request for continued examination is in response to the final Office Action dated June 8, 2004, where the Examiner has rejected claims 1-35. Claims 2-3, 13-19, 21-24 and 26-31 have been cancelled without prejudice. Claims 1, 4-7, 12 and 25 are currently amended. Accordingly, claims 1, 4-12, 20, 25 and 32-35 are pending in the present application. Reconsideration and allowance of pending claims 1, 4-12, 20, 25 and 32-35 in view of the amendments and the following remarks are respectfully requested.

A. Rejection of Claims 1, 15, 29, 32 and 35 Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

The Examiner has rejected claims 1, 15, 29, 32 and 35 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 15, 18, 19 of U.S. Patent No. 6,667,723. Applicant respectfully disagrees and asserts that claims 1, 15, 29, 32 and 35 are not unpatentable over claims 1, 15, 18, 19 of U.S. Patent No. 6,667,723 under the judicially created doctrine of obviousness-type double patenting. However, to expedite prosecution, with the present amendment, the Applicant has submitted a terminal disclaimer to overcome the Examiner's rejection under the judicially created doctrine of double patenting with respect to claims 1, 15, 18, 19 of U.S. Patent No. 6,667,723. Applicant respectfully submits that the enclosed terminal disclaimer overcomes the Examiner's double patenting rejection.

B. Rejection of Claims 29 and 35 Under 35 USC §102

The Examiner has rejected claim 29 under 35 USC §102(e) as being anticipated by Camp, Jr. et al (U.S. Patent No. 6,097,974) (hereinafter, Camp Jr.). The Examiner has further rejected

claim 35 under 35 USC §102(e) as being anticipated by Kemmochi (U.S. Patent Publication No. 20020183016) (hereinafter, Kemmochi). Regarding claim 29, Applicant respectfully disagrees. However, in order to expedite the prosecution of the present application, applicant has cancelled claim 29 without prejudice to further prosecution. Applicant reserves the right to prosecute the subject matter of cancelled claim 29 in a related application. Regarding claim 35, Applicant traverses this rejection as follows.

Claim 35 specifies “a method for receiving incoming signals from at least one of three signal bands on a single dual-band antenna of a wireless handheld communications device,” comprising among other things, the steps of:

“separating, via a diplexer, first band signals from the incoming signals and coupling the filtered first band signals to a first band *duplexer*,”

“at least one of (a) coupling the second band signals to a second band *duplexer* and (b) coupling the third band signals to a third band module.” (emphasis added).

Applicant notes that in section 4, third paragraph, of the Office Action dated June 8, 2004, the examiner cited the “duplexer” as a “diplexer”. A diplexer is not the same as a duplexer. A diplexer is defined as, “A device that permits parallel feeding of one antenna from two transmitters at the same or different frequencies without the transmitters interfering with each other. Diplexers couple transmitter and receiver to the same antenna for use in mobile communications”. Newton’s Telecom Dictionary, CMP Books, New York, NY, 2002, 18th Ed, pp. 225. A duplexer is defined as “1. A device which splits a higher speed source data stream into two separate streams for transmission over two data channels. Another duplexer at the other end puts the two slower speed streams back together into one higher-spread [sic] stream. 2. A

waveguide device designed to allow an antenna to be used [for] both transmission and reception simultaneously.” Newton’s Telecom Dictionary, CMP Books, New York, NY, 2002, 18th Ed, pp. 247. The second definition of duplexer is the relevant definition here. The first definition is shown merely for completeness.

The Office Action cites Kemmochi, para. # 0091, 0092, as showing that Kemmochi anticipates claim 35. Applicant respectfully asserts that Kemmochi does not anticipate claim 35, at least because no duplexer is taught in Kemmochi. Kemmochi may show a diplexer but not a duplexer. For at least these reasons, applicant respectfully submits that independent claim 35 is patentably distinguishable over Kemmochi.

B. Rejection of Claims 1-28 and 30-34 Under 35 USC §103

The Examiner has further rejected claims 1-28 and 30-34 under 35 USC §103(a) as being unpatentable over Kemmochi in view of Camp Jr. Applicant respectfully disagrees; however, in order to expedite the prosecution of the present application, applicant has amended independent claim 1 and cancelled claims 2-3, 13-19, 21-24 and 26-31. For the reasons that follow, applicant respectfully submits that claims 1, 4-12, 20, 35 and 32-34 are patentably distinguishable over the cited references, considered singly or in combination.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Examiner does not provide any motivation for combining the references. Both references admittedly refer to wireless communications, however, Kemmochi involves time division multiple access (TDMA) communications while Camp, Jr. involves code division multiple access CDMA communications. The receiver systems for TDMA and CDMA communications devices are different. For example, TDMA devices typically employ a switch for multiplexing the transmit and receive portions of the communications, whereas, CDMA typically does not include a switch. As such, there is no motivation to combine the Kemmochi and Camp, Jr. references. Neither has the Office Action itself provided a motivation to combine such apparently dispersant systems. Thus, the obviousness rejection is based upon the Applicant's own invention characterization, not the modification of Camp, Jr. In general, the combination of references made in Sections 6-7 of the Office Action appear to be the result of keyword searches as opposed to a true nexus of related ideas in the same field of art.

"Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue....To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that would create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art reference for combination in the manner claimed." *In re Rouffet*, 47 USPQ2d 1453, 1457-1458 (1998).

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Further, the Examiner has still not demonstrated that the modification of the cited the prior art reference points to the reasonable expectation of success in the present invention, which is the second requirement of the obviousness analysis.

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claimed invention. Independent claim 1 has been amended to specify the first communications band duplexer of claims 2 and 3 and a second communications band duplexer. The Office Action cites Kemmochi, paras. # 0089, 0093 and 0045, referring to claims 2 and 3, for the assertion that Kemmochi teaches a duplexer. Applicant respectfully disagrees. As described above with reference to claim 35, no duplexer is shown or described in Kemmochi. Kemmochi simply discloses a switch for separating the transmits port from the receive ports.

The combination of Camp, Jr. with Kemmochi still fails to suggest first and second communications band duplexers coupled to the diplexer as claimed in claim 1. Since the combination of references does not include all the limitations of the invention of claim 1, the Applicant requests that the rejection be withdrawn. Claims 4-12, 20 and 25, dependent from claim 1, include all the distinctions of the base claim.

Regarding claim 20, in addition to the reasons given above with reference to claim 1, claim 20 is patentably distinct from the cited references, because Kemmochi does not teach an attenuation in the diplexer of approximately -0.3 db.

Regarding claim 25, in addition to the reasons given above with reference to claim 1, claim 20 is patentably distinct from the cited references, because Kemmochi does not teach a high pass frequency response with a cutoff frequency at approximately 1400 MHz. This is important, because the cutoff frequency must be significantly below the GPS signal frequency at 1575 MHz in order to have sufficiently low attenuation at the GPS signal frequency.

Regarding independent claim 32, the Office Action states that Kemmochi “teaches a method for providing a system-enabled antenna, comprising the steps of (among other things): coupling, via a triplexer (triple-band, high frequency module, fig. 15, element 103, para. # 0010), band signals of the wireless communications signal to a module (paragraph # 0010, 0019)”.

Applicant respectfully asserts that Kemmochi does not teach a triplexer. Element 103 is a diplexer, not a triplexer. Kemmochi teaches a “triple-band, high frequency switch module”. Kemmochi, para. # 0010. Specifically, Kemmochi uses high speed switches for multiplexing the triple bands. See Fig. 15 and paras. # 0010 and 0011. Switches are active devices, which consume power, and introduce attenuation and noise different from that of passive devices. Triplexers are passive devices which passively multiplex signals at three different frequencies. Further, Camp, Jr. does not teach a triplexer.

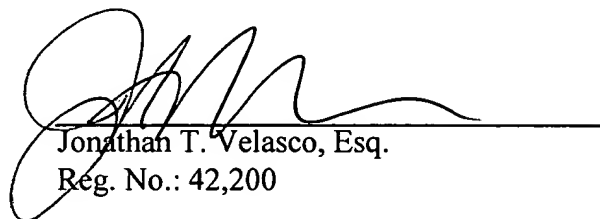
The combination of Camp, Jr. with Kemmochi still fails to suggest a triplexer as claimed in claim 32. Since the combination of references does not include all the limitations of the invention of claim 32, the Applicant requests that claim 32 be allowed. Claims 33-34, dependent from claim 32, include all the distinctions of the base claim. Applicant requests that claims 33-34 be allowed.

C. Conclusion

For all the foregoing reasons, an early allowance of claims 1, 4-12, 20, 25 and 32-35 pending in the present application is respectfully requested.

Respectfully Submitted;

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